



# Patents Act 1977

## 1977 CHAPTER 37

### PART I

#### NEW DOMESTIC LAW

##### *Patentability*

### **1 Patentable inventions.**

- (1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—
  - (a) the invention is new;
  - (b) it involves an inventive step;
  - (c) it is capable of industrial application;
  - (d) the grant of a patent for it is not excluded by subsections (2) and (3) below;and references in this Act to a patentable invention shall be construed accordingly.
- (2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—
  - (a) a discovery, scientific theory or mathematical method;
  - (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
  - (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
  - (d) the presentation of information;but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.
- (3) A patent shall not be granted—
  - (a) for an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour;

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- (b) for any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological process or the product of such a process.
- (4) For the purposes of subsection (3) above behaviour shall not be regarded as offensive, immoral or anti-social only because it is prohibited by any law in force in the United Kingdom or any part of it.
- (5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

## 2 Novelty.

- (1) An invention shall be taken to be new if it does not form part of the state of the art.
- (2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.
- (3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say—
  - (a) that matter was contained in the application for that other patent both as filed and as published; and
  - (b) the priority date of that matter is earlier than that of the invention.
- (4) For the purposes of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of six months immediately preceding the date of filing the application for the patent and either—
  - (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person—
    - (i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
    - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
  - (b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or
  - (c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the

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prescribed period, files written evidence in support of the statement complying with any prescribed conditions.

- (5) In this section references to the inventor include references to any proprietor of the invention for the time being.
- (6) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

### **3 Inventive step.**

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

### **4 Industrial application.**

- (1) Subject to subsection (2) below, an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.
- (2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.
- (3) Subsection (2) above shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any such method.

### **5 Priority date.**

- (1) For the purposes of this Act the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in any such application is, except as provided by the following provisions of this Act, the date of filing the application.
- (2) If in or in connection with an application for a patent (the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of his and each having a date of filing during the period of twelve months immediately preceding the date of filing the application in suit, then—
  - (a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed, or, if it was disclosed in more than one relevant application, the earliest of them;
  - (b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the

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date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

- (3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as concerns that invention or matter, be disregarded unless—
- (a) it was filed in or in respect of the same country as the first; and
  - (b) not later than the date of filing the second, the first (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without—
    - (i) having been made available to the public (whether in the United Kingdom or elsewhere);
    - (ii) leaving any rights outstanding; and
    - (iii) having served to establish a priority date in relation to another application, wherever made.
- (4) The foregoing provisions of this section shall apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates.
- (5) In this section “relevant application” means any of the following applications which has a date of filing, namely—
- (a) an application for a patent under this Act;
  - (b) an application in or for a convention country (specified under section 90 below) for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.

[<sup>F1</sup>(6) References in subsection (5) above to a convention country include references to a country, other than the United Kingdom, which is a member of the World Trade Organisation.]

#### Textual Amendments

**F1** S. 5(6) inserted (29.7.1999) by S.I. 1999/1899, reg. 7

#### Modifications etc. (not altering text)

**C1** S. 5 extended (24.5.2000) by S.I. 2000/1114, art. 2

## 6 Disclosure of matter, etc., between earlier and later applications.

- (1) It is hereby declared for the avoidance of doubt that where an application (the application in suit) is made for a patent and a declaration is made in accordance with section 5(2) above in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it shall not be invalidated by reason only of relevant intervening acts.
- (2) In this section—

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“relevant application” has the same meaning as in section 5 above; and  
“relevant intervening acts” means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 5(3) above.

*Right to apply for and obtain a patent and be mentioned as inventor*

## **7 Right to apply for and obtain a patent.**

- (1) Any person may make an application for a patent either alone or jointly with another.
- (2) A patent for an invention may be granted—
  - (a) primarily to the inventor or joint inventors;
  - (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
  - (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;and to no other person.
- (3) In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.
- (4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

## **8 Determination before grant of questions about entitlement to patents, etc.**

- (1) At any time before a patent has been granted for an invention (whether or not an application has been made for it)—
  - (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or
  - (b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.

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- (2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below.—
- (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;
  - (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;
  - (c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;
  - (d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.
- (3) Where a question is referred to the comptroller under subsection (1)(a) above and—
- (a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;
  - (b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or
  - (c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;
- the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.
- (4) Where a person refers a question under subsection (1)(b) above relating to an application, any order under subsection (1) above may contain directions to any person for transferring or granting any right in or under the application.
- (5) If any person to whom directions have been given under subsection (2)(d) or (4) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.
- (6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted (whether alone or with any other persons) a patent for the invention or has or would have any right in or under any patent so granted or any application for any such patent, an order shall not be made under subsection (2)(a), (b) or (d) above on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.

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- (7) If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.
- (8) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their right or obligations as such.

## **9 Determination after grant of questions referred before grant.**

If a question with respect to a patent or application is referred by any person to the comptroller under section 8 above, whether before or after the making of an application for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the comptroller under section 37 below any question mentioned in that section which the comptroller thinks appropriate.

## **10 Handling of application by joint applicants.**

If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

## **11 Effect of transfer of application under s. 8 or 10.**

- (1) Where an order is made or directions are given under section 8 or 10 above that an application for a patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.
- (2) Where an order is made or directions are given under section 8 above that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to be granted the patent), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3) below, lapse on the registration of that person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.
- (3) If before registration of a reference under section 8 above resulting in the making of any order mentioned in subsection (2) above—
  - (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so; or

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(a) a licensee of the applicant, acting in good faith, worked the invention in the United Kingdom or made effective and serious preparations to do so; that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2) above, the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the comptroller shall determine the question and may, if he considers it appropriate, order the grant of such a licence.

## **12 Determination of questions about entitlement to foreign and convention patents, etc.**

(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made)—

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

(2) If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.

(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.

(4) Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.

(5) Section 11 above shall apply in relation to—

(a) any orders made under subsection (1) above and any directions given under section 10 above by virtue of subsection (4) above; and

(b) any orders made and directions given by the relevant convention court with respect to a question corresponding to any question which may be determined under subsection (1) above;



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as it applies to orders made and directions given apart from this section under section 8 or 10 above.

(6) In the following cases, that is to say—

- (a) where an application for a European patent (UK) is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn, after publication of the application but before a question relating to the right to the patent has been referred to the comptroller under subsection (1) above or before proceedings relating to that right have begun before the relevant convention court;
- (b) where an application has been made for a European patent (UK) and on a reference under subsection (1) above or any such proceedings as are mentioned in paragraph (a) above the comptroller, the court or the relevant convention court determines by a final decision (whether before or after publication of the application) that a person other than the applicant has the right to the patent, but that person requests the European Patent Office that the application for the patent should be refused; or
- (c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above but after publication of the application;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application.

(7) In this section—

- (a) references to a patent and an application for a patent include respectively references to protection in respect of an invention and an application which, in accordance with the law of any country other than the United Kingdom or any treaty or international convention, is equivalent to an application for a patent or for such protection; and
- (b) a decision shall be taken to be final for the purposes of this section when the time for appealing from it has expired without an appeal being brought or, where an appeal is brought, when it is finally disposed of.

### **13 Mention of inventor.**

- (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.
- (2) Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement—
  - (a) identifying the person or persons whom he believes to be the inventor or inventors; and

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- (b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent; and, if he fails to do so, the application shall be taken to be withdrawn.
- (3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

*Applications*

**14 Making of application.**

- (1) Every application for a patent—
  - (a) shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner; and
  - (b) shall be accompanied by the fee prescribed for the purposes of this subsection (hereafter in this Act referred to as the filing fee).
- (2) Every application for a patent shall contain—
  - (a) a request for the grant of a patent;
  - (b) a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim; and
  - (c) an abstract;but the foregoing provision shall not prevent an application being initiated by documents complying with section 15(1) below.
- (3) The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.
- (4) ..... F2
- (5) The claim or claims shall—
  - (a) define the matter for which the applicant seeks protection;
  - (b) be clear and concise;
  - (c) be supported by the description; and
  - (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.
- (6) Without prejudice to the generality of subsection (5)(d) above, rules may provide for treating two or more inventions as being so linked as to form a single inventive concept for the purposes of this Act.
- (7) The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 2(3) above, and the comptroller may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.
- (8) ..... F2

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- (9) An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked.

#### Textual Amendments

**F2** S. 14(4)(8) repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), [Sch. 8](#)

### 15 Date of filing application.

- (1) The date of filing an application for a patent shall, subject to the following provisions of this Act, be taken to be the earliest date on which the following conditions are satisfied in relation to the application, that is to say—
- the documents filed at the Patent Office contain an indication that a patent is sought in pursuance of the application;
  - those documents identify the applicant or applicants for the patent;
  - those documents contain a description of the invention for which a patent is sought (whether or not the description complies with the other provisions of this Act and with any relevant rules); and
  - the applicant pays the filing fee.
- (2) If any drawing referred to in any such application is filed later than the date which by virtue of subsection (1) above is to be treated as the date of filing the application, but before the beginning of the preliminary examination of the application under section 17 below, the comptroller shall give the applicant an opportunity of requesting within the prescribed period that the date on which the drawing is filed shall be treated for the purposes of this Act as the date of filing the application, and—
- if the applicant makes any such request, the date of filing the drawing shall be so treated; but
  - otherwise any reference to the drawing in the application shall be treated as omitted.
- (3) If on the preliminary examination of an application under section 17 below it is found that any drawing referred to in the application has not been filed, then—
- if the drawing is subsequently filed within the prescribed period, the date on which it is filed shall be treated for the purposes of this Act as the date of filing the application; but
  - otherwise any reference to the drawing in the application shall be treated as omitted.

[<sup>F3</sup>(3A) Nothing in subsection (2) or (3) above shall be construed as affecting the power of the comptroller under section 117(1) below to correct errors or mistakes with respect to the filing of drawings.]

- (4) Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application and the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below) the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

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- (5) An application which has a date of filing by virtue of the foregoing provisions of this section shall be taken to be withdrawn at the end of the relevant prescribed period, unless before that end the applicant—
- (a) files at the Patent Office one or more claims for the purposes of the application and also the abstract; and
  - (b) makes a request for a preliminary examination and search under the following provisions of this Act and pays the search fee.

#### Textual Amendments

**F3** S. 15(3A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 2](#)

### 16 Publication of application.

- (1) Subject to section 22 below, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal.
- (2) The comptroller may omit from the specification of a published application for a patent any matter—
  - (a) which in his opinion disparages any person in a way likely to damage him, or
  - (b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

#### *Examination and search*

### 17 Preliminary examination and search.

- (1) Where an application for a patent has a date of filing and is not withdrawn, and before the end of the prescribed period—
  - (a) a request is made by the applicant to the Patent Office in the prescribed form for a preliminary examination and a search; and
  - (b) the prescribed fee is paid for the examination and search (the search fee);
 the comptroller shall refer the application to an examiner for a preliminary examination and search, except that he shall not refer the application for a search until it includes one or more claims.
- (2) On a preliminary examination of an application the examiner shall determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act and shall report his determination to the comptroller.
- (3) If it is reported to the comptroller under subsection (2) above that not all the formal requirements are complied with, he shall give the applicant an opportunity to make

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observations on the report and to amend the application within a specified period (subject to section 15(5) above) so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to do so the comptroller may refuse the application.

- (4) Subject to subsections (5) and (6) below, on a search requested under this section, the examiner shall make such investigation as in his opinion is reasonably practicable and necessary for him to identify the documents which he thinks will be needed to decide, on a substantive examination under section 18 below, whether the invention for which a patent is sought is new and involves an inventive step.
- (5) On any such search the examiner shall determine whether or not the search would serve any useful purpose on the application as for the time being constituted and—
- (a) if he determines that it would serve such a purpose in relation to the whole or part of the application, he shall proceed to conduct the search so far as it would serve such a purpose and shall report on the results of the search to the comptroller; and
  - (b) if he determines that the search would not serve such a purpose in relation to the whole or part of the application, he shall report accordingly to the comptroller;

and in either event the applicant shall be informed of the examiner's report.

- (6) If it appears to the examiner, either before or on conducting a search under this section, that an application relates to two or more inventions, but that they are not so linked as to form a single inventive concept, he shall initially only conduct a search in relation to the first invention specified in the claims of the application, but may proceed to conduct a search in relation to another invention so specified if the applicant pays the search fee in respect of the application so far as it relates to that other invention.
- (7) After a search has been requested under this section for an application the comptroller may at any time refer the application to an examiner for a supplementary search, and [F4subsections (4) and (5) above] shall apply in relation to a supplementary search as [F4they apply] in relation to any other search under this section.

- [F5(8) A reference for a supplementary search in consequence of—
- (a) an amendment of the application made by the applicant under section 18(3) or 19(1) below, or
  - (b) a correction of the application, or of a document filed in connection with the application, under section 117 below,
- shall be made only on payment of the prescribed fee, unless the comptroller directs otherwise.]

#### Textual Amendments

**F4** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 3\(2\)](#)

**F5** S. 17(8) added by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 3\(3\)](#)

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## 18 Substantive examination and grant or refusal of patent.

(1) Where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a preliminary examination and search are satisfied and at the time of the request under that subsection or within the prescribed period—

- (a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and
- (b) the prescribed fee is paid for the examination;

the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period.

[<sup>F6</sup>(1A) If the examiner forms the view that a supplementary search under section 17 above is required for which a fee is payable, he shall inform the comptroller, who may decide that the substantive examination should not proceed until the fee is paid; and if he so decides, then unless within such period as he may allow—

- (a) the fee is paid, or
- (b) the application is amended so as to render the supplementary search unnecessary,

he may refuse the application.]

(2) On a substantive examination of an application the examiner shall investigate, to such extent as he considers necessary in view of any examination and search carried out under section 17 above, whether the application complies with the requirements of this Act and the rules and shall determine that question and report his determination to the comptroller.

(3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

(4) If the examiner reports that the application, whether as originally filed or as amended in pursuance of section 17 above, this section or section 19 below, complies with those requirements at any time before the end of the prescribed period, the comptroller shall notify the applicant of that fact and, subject to subsection (5) and sections 19 and 22 below and on payment within the prescribed period of any fee prescribed for the grant, grant him a patent.

(5) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

### Textual Amendments

**F6** S. 18(1A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 4](#)

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## 19 General power to amend application before grant.

- (1) At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.
- (2) The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark.

### Modifications etc. (not altering text)

- C2 S. 19(2) extended by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 67A\)](#) s. 2(3), Sch. 2 Pt. I para. 1(2)(e)(i)  
S. 19(2) amended (31.10.1994) by [1994 c. 26, s. 106\(1\)](#), [Sch. 4 para. 1\(2\)](#); [S.I. 1994/2550, art. 2](#)

## 20 Failure of application.

- (1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.
- (2) If at the end of that period an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period—
  - (a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, shall be extended until such date as the court may determine;
  - (b) where no such appeal is pending or is so brought, shall continue until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

## 21 Observations by third party on patentability.

- (1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.
- (2) It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.

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### *Security and safety*

## **22 Information prejudicial to defence of realm or safety of public.**

- (1) Where an application for a patent is filed in the Patent Office (whether under this Act or any treaty or international convention to which the United Kingdom is a party and whether before or after the appointed day) and it appears to the comptroller that the application contains information of a description notified to him by the Secretary of State as being information the publication of which might be prejudicial to the defence of the realm, the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.
- (2) If it appears to the comptroller that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 16 above.
- (3) While directions are in force under this section with respect to an application—
  - (a) if the application is made under this Act, it may proceed to the stage where it is in order for the grant of a patent, but it shall not be published and that information shall not be so communicated and no patent shall be granted in pursuance of the application;
  - (b) if it is an application for a European patent, it shall not be sent to the European Patent Office; and
  - (c) if it is an international application for a patent, a copy of it shall not be sent to the International Bureau or any international searching authority appointed under the Patent Co-operation Treaty.
- (4) Subsection (3)(b) above shall not prevent the comptroller from sending the European Patent Office any information which it is his duty to send that office under the European Patent Convention.
- (5) Where the comptroller gives directions under this section with respect to any application, he shall give notice of the application and of the directions to the Secretary of State, and the following provisions shall then have effect:—
  - (a) the Secretary of State shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of the realm or the safety of the public;
  - (b) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to the safety of the public, he shall notify the comptroller who shall continue his directions under subsection (2) above until they are revoked under paragraph (e) below;
  - (c) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to the defence of the realm or the safety of the public, he shall (unless a notice under paragraph (d) below has previously been given by the Secretary of State to the comptroller) reconsider



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- that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;
- (d) if on consideration of an application at any time it appears to the Secretary of State that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the defence of the realm or the safety of the public, he shall give notice to the comptroller to that effect; and
- (e) on receipt of such a notice the comptroller shall revoke the directions and may, subject to such conditions (if any) as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.
- (6) The Secretary of State may do the following for the purpose of enabling him to decide the question referred to in subsection (5)(c) above—
- (a) where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, he may at any time do one or both of the following, that is to say, inspect and authorise the United Kingdom Atomic Energy Authority to inspect the application and any documents sent to the comptroller in connection with it; and
- (b) in any other case, he may at any time after (or, with the applicant's consent, before) the end of the period prescribed for the purposes of section 16 above inspect the application and any such documents;
- and where that Authority are authorised under paragraph (a) above they shall as soon as practicable report on their inspection to the Secretary of State.
- (7) Where directions have been given under this section in respect of an application for a patent for an invention and, before the directions are revoked, that prescribed period expires and the application is brought in order for the grant of a patent, then—
- (a) if while the directions are in force the invention is worked by (or with the written authorisation of or to the order of) a government department, the provisions of sections 55 to 59 below shall apply as if—
- (i) the working were use made by section 55;
- (ii) the application had been published at the end of that period; and
- (iii) a patent had been granted for the invention at the time the application is brought in order for the grant of a patent (taking the terms of the patent to be those of the application as it stood at the time it was so brought in order); and
- (b) if it appears to the Secretary of State that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Secretary of State may, with the consent of the Treasury, make such payment (if any) by way of compensation to the applicant as appears to the Secretary of State and the Treasury to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.
- (8) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.
- (9) A person who fails to comply with any direction under this section shall be liable—
- (a) on summary conviction, to a fine not exceeding £1,000; or

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- (b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

### **23 Restrictions on applications abroad by United Kingdom residents.**

- (1) Subject to the following provisions of this section, no person resident in the United Kingdom shall, without written authority granted by the comptroller, file or cause to be filed outside the United Kingdom an application for a patent for an invention unless—
  - (a) an application for a patent for the same invention has been filed in the Patent Office (whether before, on or after the appointed day) not less than six weeks before the application outside the United Kingdom; and
  - (b) either no directions have been given under section 22 above in relation to the application in the United Kingdom or all such directions have been revoked.
- (2) Subsection (1) above does not apply to an application for a patent for an invention for which an application for a patent has first been filed (whether before or after the appointed day) in a country outside the United Kingdom by a person resident outside the United Kingdom.
- (3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section shall be liable—
  - (a) on summary conviction, to a fine not exceeding £1,000; or
  - (b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.
- (4) In this section—
  - (a) any reference to an application for a patent includes a reference to an application for other protection for an invention;
  - (b) any reference to either kind of application is a reference to an application under this Act, under the law of any country other than the United Kingdom or under any treaty or international convention to which the United Kingdom is a party.

#### *Provisions as to patents after grant*

### **24 Publication and certificate of grant.**

- (1) As soon as practicable after a patent has been granted under this Act the comptroller shall publish in the journal a notice that it has been granted.
- (2) The comptroller shall, as soon as practicable after he publishes a notice under subsection (1) above, send the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor.
- (3) The comptroller shall, at the same time as he publishes a notice under subsection (1) above in relation to a patent publish the specification of the patent, the names of the proprietor and (if different) the inventor and any other matters constituting or relating to the patent which in the comptroller's opinion it is desirable to publish.

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## **25 Term of patent.**

- (1) A patent granted under this Act shall be treated for the purposes of the following provisions of this Act as having been granted, and shall take effect, on the date on which notice of its grant is published in the journal and, subject to subsection (3) below, shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent or with such other date as may be prescribed.
- (2) A rule prescribing any such other date under this section shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.
- (3) A patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within that period.
- (4) If during the period of six months immediately following the end of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly—
  - (a) anything done under or in relation to it during that further period shall be valid;
  - (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
  - (c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.
- (5) Rules shall include provision requiring the comptroller to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Patent Office before the end of the prescribed period and before the framing of the notification.

## **26 Patent not to be impugned for lack of unity.**

No person may in any proceeding object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate—

- (a) to more than one invention, or
- (b) to a group of inventions which are not so linked as to form a single inventive concept.

## **27 General power to amend specification after grant.**

- (1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.
- (2) No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue.
- (3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.
- (4) The comptroller may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.

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- (5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

**Modifications etc. (not altering text)**

**C3** S. 27(4) extended by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 67A\)](#), s. 2(3), **Sch. 2 Pt. I para. 1(2)(e)(ii)**  
S. 27(4) amended (31.10.1994) by [1994 c. 26, s. 106\(1\)](#), **Sch. 4 para. 1(2)**; [S.I. 1994/2550](#) art. 2

**28 Restoration of lapsed patents.**

[<sup>F7</sup>(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(1A) Rules prescribing that period may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient.]

- (2) An application under this section may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was held by two or more persons jointly, the application may, with the leave of the comptroller, be made by one or more of them without joining the others.

[<sup>F8</sup>(2A) Notice of the application shall be published by the comptroller in the prescribed manner.]

- (3) If the comptroller is satisfied that—
  - (a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, . . . <sup>F9</sup>

the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

- (4) An order under this section may be made subject to such conditions as the comptroller thinks fit (including a condition requiring compliance with any provisions of the rules relating to registration which have not been complied with), and if the proprietor of the patent does not comply with any condition of such an order the comptroller may revoke the order and give such directions consequential on the revocation as he thinks fit.

- (5) . . . . . <sup>F10</sup>

**Textual Amendments**

**F7** S. 28(1)(1A) substituted and inserted respectively by [Copyright, Designs and Patents Act 1988 \(c.48, SIF 67A\)](#), s. 295, **Sch. 5 para. 6(2)**

**F8** S. 28(2A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 6(3)**

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- F9** Words repealed (with savings) by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), ss. 295, 303(2), [Sch. 5 para. 6\(4\)](#), [Sch. 8](#)
- F10** S. 28(5)–(9) repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), ss. 295, 303(2), [Sch. 5 para. 6\(5\)](#), [Sch. 8](#)

## [<sup>F11</sup>28A Effect of order for restoration of patent.

- (1) The effect of an order for the restoration of a patent is as follows.
- (2) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.
- (3) Anything done during that period which would have constituted an infringement if the patent had not expired shall be treated as an infringement—
  - (a) if done at a time when it was possible for the patent to be renewed under section 25(4), or
  - (b) if it was a continuation or repetition of an earlier infringing act.
- (4) If after it was no longer possible for the patent to be so renewed, and before publication of notice of the application for restoration, a person—
  - (a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired, or
  - (b) made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent; but this right does not extend to granting a licence to another person to do the act.
- (5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) may—
  - (a) authorise the doing of that act by any partners of his for the time being in that business, and
  - (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.
- (6) Where a product is disposed of to another in exercise of the rights conferred by subsection (4) or (5), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.
- (7) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to infringement of the patent.]

### Textual Amendments

- F11** S. 28A inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 7](#)

## 29 Surrender of patents.

- (1) The proprietor of a patent may at any time by notice given to the comptroller offer to surrender his patent.

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- (2) A person may give notice to the comptroller of his opposition to the surrender of a patent under this section, and if he does so the comptroller shall notify the proprietor of the patent and determine the question.
- (3) If the comptroller is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the date when notice of his acceptance is published in the journal, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the services of the Crown.

*Property in patents and applications, and registration*

**30 Nature of, and transactions in, patents and applications for patents.**

- (1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (7) below.
- (2) Subject to section 36(3) below, any patent or any such application, or any right in it, may be assigned or mortgaged.
- (3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (4) Subject to section 36(3) below, a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application; and—
  - (a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and
  - (b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (5) Subsections (2) to (4) above shall have effect subject to the following provisions of this Act.
- (6) Any of the following transactions, that is to say—
  - (a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;
  - (b) any assent relating to any patent or any such application or right;
 shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.
- (7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 61 or 69 below for a previous infringement or to bring proceedings under section 58 below for a previous act.

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### **31 Nature of, and transactions in, patents and applications for patents in Scotland.**

- (1) Section 30 above shall not extend to Scotland, but instead the following provisions of this section shall apply there.
- (2) Any patent or application for a patent, and any right in or under any patent or any such application, is incorporeal moveable property, and the provisions of the following subsections and of section 36(3) below shall apply to any grant of licences, assignments and securities in relation to such property.
- (3) Any patent or any such application, or any right in it, may be assigned and security may be granted over a patent or any such application or right.
- (4) A licence may be granted, under any patent or any application for a patent, for working the invention which is the subject of the patent or the application.
- (5) To the extent that any licence granted under subsection (4) above so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned and security may be granted over it.
- (6) Any assignment or grant of security under this section may be carried out only by writing [<sup>F12</sup>subscribed in accordance with the Requirements of Writing (Scotland) Act 1995.]
- (7) An assignment of a patent or application for a patent or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 61 or 69 below for a previous infringement or to bring proceedings under section 58 below for a previous act.

#### **Textual Amendments**

**F12** Words in s. 31(6) substituted (1.8.1995) by 1995 c. 7, ss. 14(1), 15(2), **Sch. 4 para. 49** (with ss. 9(3)(5) (7), 13, 14(3))

### **[<sup>F13</sup>32 Register of patents etc.**

- (1) The comptroller shall maintain the register of patents, which shall comply with rules made by virtue of this section and shall be kept in accordance with such rules.
- (2) Without prejudice to any other provision of this Act or rules, rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters—
  - (a) the registration of patents and of published applications for patents;
  - (b) the registration of transactions, instruments or events affecting rights in or under patents and applications;
  - (c) the furnishing to the comptroller of any prescribed documents or description of documents in connection with any matter which is required to be registered;
  - (d) the correction of errors in the register and in any documents filed at the Patent Office in connection with registration; and
  - (e) the publication and advertisement of anything done under this Act or rules in relation to the register.

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- (3) Notwithstanding anything in subsection (2)(b) above, no notice of any trust, whether express, implied or constructive, shall be entered in the register and the comptroller shall not be affected by any such notice.
- (4) The register need not be kept in documentary form.
- (5) Subject to rules, the public shall have a right to inspect the register at the Patent Office at all convenient times.
- (6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.
- (7) Applications under subsection (6) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.
- (8) In relation to any portion of the register kept otherwise than in documentary form—
  - (a) the right of inspection conferred by subsection (5) above is a right to inspect the material on the register; and
  - (b) the right to a copy or extract conferred by subsection (6) above or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (9) Subject to subsection (12) below, the register shall be prima facie evidence of anything required or authorised by this Act or rules to be registered and in Scotland shall be sufficient evidence of any such thing.
- (10) A certificate purporting to be signed by the comptroller and certifying that any entry which he is authorised by this Act or rules to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence, and in Scotland shall be sufficient evidence, of the matters so certified.
- (11) Each of the following, that is to say—
  - (a) a copy of an entry in the register or an extract from the register which is supplied under subsection (6) above;
  - (b) a copy of any document kept in the Patent Office or an extract from any such document, any specification of a patent or any application for a patent which has been published,which purports to be a certified copy or a certified extract shall, subject to subsection (12) below, be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.
- (12) In the application of this section to England and Wales nothing in it shall be taken as detracting from section 69 or 70 of the Police and Criminal Evidence Act <sup>M1</sup>1984 or any provision made by virtue of either of them.
- (13) In this section “certified copy” and “certified extract” mean a copy and extract certified by the comptroller and sealed with the seal of the Patent Office.
- (14) In this Act, except so far as the context otherwise requires—

“register”, as a noun, means the register of patents;



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“register”, as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, in relation to a person, means to enter his name in the register;  
and cognate expressions shall be construed accordingly.]

#### Textual Amendments

**F13** S. 32 substituted by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A), s. 1, Sch. 1 para. 4

#### Marginal Citations

**M1** 1984 c.60 (95).

### 33 Effect of registration, etc., on rights in patents.

- (1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event—
  - (a) the earlier transaction, instrument or event was not registered, or
  - (b) in the case of any application which has not been published, notice of the earlier transaction, instrument or event had not been given to the comptroller, and
  - (c) in any case, the person claiming under the later transaction, instrument or event, did not know of the earlier transaction, instrument or event.
- (2) Subsection (1) above shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent, by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.
- (3) This section applies to the following transactions, instruments and events:—
  - (a) the assignment or assignation of a patent or application for a patent, or a right in it;
  - (b) the mortgage of a patent or application or the granting of security over it;
  - (c) the grant, assignment or assignation of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application;
  - (d) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right; and
  - (e) any order or directions of a court or other competent authority—
    - (i) transferring a patent or application or any right in or under it to any person; or
    - (ii) that an application should proceed in the name of any person;and in either case the event by virtue of which the court or authority had power to make any such order or give any such directions.

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- (4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a) above, registration of the application shall be treated as registration of the transaction, instrument or event.

### 34 **Rectification of register.**

- (1) The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.
- (2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) Rules of court may provide for the notification of any application under this section to the comptroller and for his appearance on the application and for giving effect to any order of the court on the application.

### 35 ..... F14

#### **Textual Amendments**

**F14** S. 35 repealed by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 67A\)](#), s. 3(1), [Sch. 3 Pt. I](#)

### 36 **Co-ownership of patents and applications for patents.**

- (1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.
- (2) Where two or more persons are proprietors of a patent, then, subject to the provisions of this section and subject to any agreement to the contrary—
- (a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and section 55 below, amount to an infringement of the patent concerned; and
- (b) any such act shall not amount to an infringement of the patent concerned.
- (3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.
- (4) Subject to the provisions of those sections, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.
- (5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal

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with the product in the same way as if it had been disposed of by a sole registered proprietor.

- (6) Nothing in subsection (1) or (2) above shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.
- (7) The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and—
  - (a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and
  - (b) the reference in subsection (5) above to a patented product shall be construed accordingly.

### **37 Determination of right to patent after grant.**

- [<sup>F15</sup>(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question—
- (a) who is or are the true proprietor or proprietors of the patent,
  - (b) whether the patent should have been granted to the person or persons to whom it was granted, or
  - (c) whether any right in or under the patent should be transferred or granted to any other person or persons;
- and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.]
- (2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision—
    - (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;
    - (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
    - (c) granting any licence or other right in or under the patent;
    - (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.
  - (3) If any person to whom directions have been given under subsection (2)(d) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the order containing the directions was made, authorise him to do that thing on behalf of the person to whom the directions were given.
  - (4) Where the comptroller finds on a reference under [<sup>F16</sup>this section] that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 72 below makes an order on that ground for the conditional or unconditional revocation of the patent, the comptroller may order that the person by whom the application was made or his successor in title may, subject to section 76 below, make a new application for a patent—

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- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
- (b) in the case of conditional revocation, for the matter which in the opinion of the comptroller should be excluded from that specification by amendment under section 75 below;

and where such a new application is made, it shall be treated as having been filed on the date of filing the application for the patent to which the reference relates.

- (5) On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the end of the period of two years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.
- (6) An order under this section shall not be so made as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.
- (7) Where a question is referred to the comptroller under [<sup>F16</sup>this section] an order shall not be made by virtue of subsection (2) or under subsection (4) above on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent, except those who are parties to the reference.
- (8) If it appears to the comptroller on a reference under [<sup>F17</sup>this section] that the question referred to him would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.
- (9) The court shall not in the exercise of any such declaratory jurisdiction determine a question whether a patent was granted to a person not entitled to be granted the patent if the proceedings in which the jurisdiction is invoked were commenced after the end of the period of two years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

#### Textual Amendments

- F15** S. 37(1) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 9(2)**
- F16** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 9(3)(a)**
- F17** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 9(3)(b)**

### 38 Effect of transfer of patent under s. 37.

- (1) Where an order is made under section 37 above that a patent shall be transferred from any person or persons (the old proprietor or proprietors) to one or more persons

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(whether or not including an old proprietor), then, except in a case falling within subsection (2) below, any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 33 above and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the new proprietor or proprietors).

- (2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor (on the ground that the patent was granted to a person not entitled to be granted the patent), any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3) below, lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.
- (3) Where an order is so made that a patent shall be transferred as mentioned in subsection (2) above or that a person other than an old proprietor may make a new application for a patent and before the reference of the question under that section resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so, the old proprietor or proprietors or the licensee shall, on making a request to the new proprietor or proprietors within the prescribed period, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.
- (4) Any such licence shall be granted for a reasonable period and on reasonable terms.
- (5) The new proprietor or proprietors of the patent or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether that person is so entitled and whether any such period is or terms are reasonable, and the comptroller shall determine the question and may, if he considers it appropriate, order the grant of such a licence.

### *Employees' inventions*

## **39 Right to employees' inventions.**

- (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—
  - (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
  - (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.
- (2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.
- [<sup>F18</sup>(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

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- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or
  - (b) by any person for the purpose of performing or working the invention,
- shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.]

#### Textual Amendments

**F18** S. 39(3) added by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 11\(1\)](#)

#### 40 Compensation of employees for certain inventions.

- (1) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer, the court or the comptroller may award him such compensation of an amount determined under section 41 below.
- (2) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—
  - (a) a patent has been granted for an invention made by and belonging to the employee;
  - (b) his rights in the invention, or in any patent or application for a patent for the invention, have since the appointed day been assigned to the employer or an exclusive licence under the patent or application has since the appointed day been granted to the employer;
  - (c) the benefit derived by the employee from the contract of assignment, assignation or grant or any ancillary contract (“the relevant contract”) is inadequate in relation to the benefit derived by the employer from the patent; and
  - (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract;

the court or the comptroller may award him such compensation of an amount determined under section 41 below.
- (3) Subsections (1) and (2) above shall not apply to the invention of an employee where a relevant collective agreement provides for the payment of compensation in respect of inventions of the same description as that invention to employees of the same description as that employee.
- (4) Subsection (2) above shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention (other than any such collective agreement).

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- (5) If it appears to the comptroller on an application under this section that the application involves matters which would more properly be determined by the court, he may decline to deal with it.
- (6) In this section—
- “the prescribed period”, in relation to proceedings before the court, means the period prescribed by rules of court, and
- “relevant collective agreement” means a collective agreement within the meaning of [<sup>F19</sup>the Trade Union and Labour Relations (Consolidation) Act 1992], made by or on behalf of a trade union to which the employee belongs, and by the employer or an employers’ association to which the employer belongs which is in force at the time of the making of the invention.
- (7) References in this section to an invention belonging to an employer or employee are references to it so belonging as between the employer and the employee.

#### Textual Amendments

**F19** Words in s. 40(6) substituted (16.10.1992) by [Trade Union and Labour Relations \(Consolidation\) Act 1992 \(c. 52\), ss. 300\(2\), 302, Sch. 2 para. 9](#)

## 41 Amount of compensation.

- (1) An award of compensation to an employee under section 40(1) or (2) above in relation to a patent for an invention shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from the patent or from the assignment, assignation or grant to a person connected with the employer of the property or any right in the invention or the property in, or any right in or under, an application for that patent.
- (2) For the purposes of subsection (1) above the amount of any benefit derived or expected to be derived by an employer from the assignment, assignation or grant of—
- (a) the property in, or any right in or under, a patent for the invention or an application for such a patent; or
- (b) the property or any right in the invention;
- to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.
- (3) Where the Crown or a Research Council in its capacity as employer assigns or grants the property in, or any right in or under, an invention, patent or application for a patent to a body having among its functions that of developing or exploiting inventions resulting from public research and does so for no consideration or only a nominal consideration, any benefit derived from the invention, patent or application by that body shall be treated for the purposes of the foregoing provisions of this section as so derived by the Crown or, as the case may be, Research Council.

In this subsection “Research Council” means a body which is a Research Council for the purposes of the <sup>M2</sup>Science and Technology Act 1965.

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- (4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to an employer, the court or the comptroller shall, among other things, take the following matters into account, that is to say—
- (a) the nature of the employee’s duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Act;
  - (b) the effort and skill which the employee has devoted to making the invention;
  - (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
  - (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.
- (5) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which originally belonged to him, the court or the comptroller shall, among other things, take the following matters into account, that is to say—
- (a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent;
  - (b) the extent to which the invention was made jointly by the employee with any other person; and
  - (c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (4)(d) above.
- (6) Any order for the payment of compensation under section 40 above may be an order for the payment of a lump sum or for periodical payment, or both.
- (7) Without prejudice to [<sup>F20</sup>section 12 or section 14 of the <sup>M3</sup>Interpretation Act 1978], the refusal of the court or the comptroller to make any such order on an application made by an employee under section 40 above shall not prevent a further application being made under that section by him or any successor in title of his.
- (8) Where the court or the comptroller has made any such order, the court or he may on the application of either the employer or the employee vary or discharge it or suspend any provision of the order and revive any provision so suspended, and section 40(5) above shall apply to the application as it applies to an application under that section.
- (9) In England and Wales any sums awarded by the comptroller under section 40 above shall, if a county court so orders, be recoverable by execution issued from the county court or otherwise as if they were payable under an order of that court.
- (10) In Scotland an order made under section 40 above by the comptroller for the payment of any sums may be enforced in like manner as a recorded decree arbitral.
- (11) In Northern Ireland an order made under section 40 above by the comptroller for the payment of any sums may be enforced as if it were a money judgment.

#### Textual Amendments

**F20** Words substituted by virtue of [Interpretation Act 1978 \(c. 30\), s. 25\(2\)](#)



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#### Marginal Citations

- M2 1965 c. 4.  
M3 1978 c. 30.

### 42 Enforceability of contracts relating to employees' inventions.

- (1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—
  - (a) with the employer (alone or with another); or
  - (b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.
- (2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the appointed day and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.
- (3) Subsection (2) above shall not be construed as derogating from any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.
- (4) This section applies to any arrangement made with a Crown employee by or on behalf of the Crown as his employer as it applies to any contract made between an employee and an employer other than the Crown, and for the purposes of this section "Crown employee" means a person employed under or for the purposes of a government department or any officer or body exercising on behalf of the Crown functions conferred by any enactment [<sup>F21</sup> or a person serving in the naval, military or air forces of the Crown.]

#### Textual Amendments

- F21 Words added (retrospectively) by [Armed Forces Act 1981 \(c. 55, SIF 7:1\), s. 22\(1\)\(2\)](#)

### 43 Supplementary.

- (1) Sections 39 to 42 above shall not apply to an invention made before the appointed day.
- (2) Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say—
  - (a) he was mainly employed in the United Kingdom; or
  - (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.
- (3) In sections 39 to 42 above and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to

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his merely contributing advice or other assistance in the making of an invention by another employee.

- (4) Any references [<sup>F22</sup>in sections 39 to 42] above to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of the United Kingdom or the law in force in any other country or under any treaty or international convention.
- (5) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 40 above in respect of the patent, include any benefit derived or expected to be derived from the patent by his personal representatives or by any person in whom it was vested by their assent.
- (6) Where an employee dies before an award is made under section 40 above in respect of a patented invention made by him, his personal representatives or their successors in title may exercise his right to make or proceed with an application for compensation under subsection (1) or (2) of that section.
- (7) In sections 40 and 41 above and this section “benefit” means benefit in money or money’s worth.
- (8) Section 533 of the <sup>M4</sup>Income and Corporation Taxes Act 1970 (definition of connected persons) shall apply for determining for the purposes of section 41(2) above whether one person is connected with another as it applies for determining that question for the purposes of the Tax Acts.

#### Textual Amendments

**F22** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 11\(2\)](#)

#### Marginal Citations

**M4** [1970 c. 10.](#)

*Contracts as to patented products, etc.*

#### 44 Avoidance of certain restrictive conditions.

- (1) Subject to the provisions of this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far it purports—
  - (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;
  - (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied;

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- (c) in either case, to prohibit the person supplied or licensee from using articles (whether patented products or not) which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.
- (2) Subsection (1) above applies to contracts and licences whether made or granted before or after the appointed day, but not to those made or granted before 1st January 1950.
- (3) In proceedings against any person for infringement of a patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or pursuer or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.
- (4) A condition or term of a contract or licence shall not be void by virtue of this section if—
  - (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or licensee, on reasonable terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1) above; and
  - (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party three months' notice in writing and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may be determined by an arbitrator or arbiter appointed by the Secretary of State.
- (5) If in any proceeding it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall lie on the supplier or licensor to prove the matters set out in paragraph (a) of subsection (4) above.
- (6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specific person or, in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor (or, in Scotland, hirer) or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

**Modifications etc. (not altering text)**

C4 S. 44 continued (1.3.2000) by S.I. 2000/311, art. 3(a)

**45 Determination of parts of certain contracts.**

- (1) Any contract for the supply of a patented product or licence to work a patented invention, or contract relating to any such supply or licence, may at any time after the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or licence or in any other contract, be determined, to the extent (and only to the extent) that the contract

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or licence relates to the product or invention, by either party on giving three months' notice in writing to the other party.

- (2) In subsection (1) above “patented product” and “patented invention” include respectively a product and an invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application which had been filed before that time, as it applies to a patent in force at that time.
- (3) If, on an application under this subsection made by either party to a contract or licence falling within subsection (1) above, the court is satisfied that, in consequence of the patent or patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all the terms and conditions of the contract or licence, it may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.
- (4) Without prejudice to any other right of recovery, nothing in subsection (1) above shall be taken to entitle any person to recover property bailed under a hire-purchase agreement (within the meaning of the <sup>M5</sup>Consumer Credit Act 1974).
- (5) The foregoing provisions of this section apply to contracts and licences whether made before or after the appointed day.
- (6) The provisions of this section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.

**Modifications etc. (not altering text)**

C5 S. 45 continued (1.3.2000) by S.I. 2000/311, art. 3(b)

**Marginal Citations**

M5 1974 c. 39.

*Licences of right and compulsory licences*

**46 Patentee's application for entry in register that licences are available as of right.**

- (1) At any time after the grant of a patent its proprietor may apply to the comptroller for an entry to be made in the register to the effect that licences under the patent are to be available as of right.
- (2) Where such an application is made, the comptroller shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make that entry.
- (3) Where such an entry is made in respect of a patent—
  - (a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the comptroller on the application of the proprietor of the patent or the person requiring the licence;

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- (b) the comptroller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;
- (c) if in proceedings for infringement of the patent (otherwise than by the importation of any article [<sup>F23</sup>from a country which is not a member State of the European Economic Community]) the defendant or defender undertakes to take a licence on such terms, no injunction or interdict shall be granted against him and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement;
- (d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.

[<sup>F24</sup>(3A) An undertaking under subsection (3)(c) above may be given at any time before final order in the proceedings, without any admission of liability.]

- (4) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were proprietor, making the proprietor a defendant or defender.
- (5) A proprietor so added as defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

#### Textual Amendments

**F23** Words inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 295, Sch. 5 para. 12\(2\)](#)

**F24** S. 46(3A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 295, Sch. 5 para. 12\(3\)](#)

#### 47 Cancellation of entry made under s. 46.

- (1) At any time after an entry has been made under section 46 above in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.
- (2) Where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.
- (3) Within the prescribed period after an entry has been made under section 46 above in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the comptroller for cancellation of the entry.
- (4) Where the comptroller is satisfied, on an application under subsection (3) above, that the proprietor of the patent is and was so precluded, he shall cancel the entry; and the proprietor shall then be liable to pay, within a period specified by the comptroller, a

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sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

- (5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall afterwards be the same as if the entry had not been made.
- (6) Where an application has been made under this section, then—
- (a) in the case of an application under subsection (1) above, any person, and
  - (b) in the case of an application under subsection (3) above, the proprietor of the patent,

may within the prescribed period give notice to the comptroller of opposition to the cancellation; and the comptroller shall, in considering the application, determine whether the opposition is justified.

**[48] <sup>F25</sup>Compulsory licences: general.**

- (1) At any time after the expiration of three years, or of such other period as may be prescribed, from the date of the grant of a patent, any person may apply to the comptroller on one or more of the relevant grounds—
- (a) for a licence under the patent;
  - (b) for an entry to be made in the register to the effect that licences under the patent are to be available as of right; or
  - (c) where the applicant is a government department, for the grant to any person specified in the application of a licence under the patent.
- (2) Subject to sections 48A and 48B below, if he is satisfied that any of the relevant grounds are established, the comptroller may—
- (a) where the application is under subsection (1)(a) above, order the grant of a licence to the applicant on such terms as the comptroller thinks fit;
  - (b) where the application is under subsection (1)(b) above, make such an entry as is there mentioned;
  - (c) where the application is under subsection (1)(c) above, order the grant of a licence to the person specified in the application on such terms as the comptroller thinks fit.
- (3) An application may be made under this section in respect of a patent even though the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in the relevant grounds by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted a licence.
- (4) In this section “the relevant grounds” means—
- (a) in the case of an application made in respect of a patent whose proprietor is a WTO proprietor, the grounds set out in section 48A(1) below;
  - (b) in any other case, the grounds set out in section 48B(1) below.
- (5) A proprietor is a WTO proprietor for the purposes of this section and sections 48A, 48B, 50 and 52 below if—
- (a) he is a national of, or is domiciled in, a country which is a member of the World Trade Organisation; or

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- (b) he has a real and effective industrial or commercial establishment in such a country.
- (6) A rule prescribing any such other period under subsection (1) above shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.]

#### Textual Amendments

F25 S. 48 substituted (29.7.1999) by S.I. 1999/1899, reg. 3

#### [48A <sup>F26</sup>Compulsory licences: WTO proprietors.

- (1) In the case of an application made under section 48 above in respect of a patent whose proprietor is a WTO proprietor, the relevant grounds are—
- (a) where the patented invention is a product, that a demand in the United Kingdom for that product is not being met on reasonable terms;
  - (b) that by reason of the refusal of the proprietor of the patent concerned to grant a licence or licences on reasonable terms—
    - (i) the exploitation in the United Kingdom of any other patented invention which involves an important technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted is prevented or hindered, or
    - (ii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced;
  - (c) that by reason of conditions imposed by the proprietor of the patent concerned on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced.
- (2) No order or entry shall be made under section 48 above in respect of a patent whose proprietor is a WTO proprietor unless—
- (a) the applicant has made efforts to obtain a licence from the proprietor on reasonable commercial terms and conditions; and
  - (b) his efforts have not been successful within a reasonable period.
- (3) No order or entry shall be so made if the patented invention is in the field of semiconductor technology.
- (4) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(b)(i) above unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.
- (5) A licence granted in pursuance of an order or entry so made shall not be assigned except to a person to whom the patent for the other invention is also assigned.
- (6) A licence granted in pursuance of an order or entry made under section 48 above in respect of a patent whose proprietor is a WTO proprietor—

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- (a) shall not be exclusive;
- (b) shall not be assigned except to a person to whom there is also assigned the part of the enterprise that enjoys the use of the patented invention, or the part of the goodwill that belongs to that part;
- (c) shall be predominantly for the supply of the market in the United Kingdom;
- (d) shall include conditions entitling the proprietor of the patent concerned to remuneration adequate in the circumstances of the case, taking into account the economic value of the licence; and
- (e) shall be limited in scope and in duration to the purpose for which the licence was granted.]

#### Textual Amendments

**F26** S. 48A inserted (29.7.1999) by [S.I. 1999/1899](#), [reg. 4](#)

#### **[48B** <sup>F27</sup>**Compulsory licences: other cases.**

- (1) In the case of an application made under section 48 above in respect of a patent whose proprietor is not a WTO proprietor, the relevant grounds are–
- (a) where the patented invention is capable of being commercially worked in the United Kingdom, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;
  - (b) where the patented invention is a product, that a demand for the product in the United Kingdom–
    - (i) is not being met on reasonable terms, or
    - (ii) is being met to a substantial extent by importation from a country which is not a member State;
  - (c) where the patented invention is capable of being commercially worked in the United Kingdom, that it is being prevented or hindered from being so worked–
    - (i) where the invention is a product, by the importation of the product from a country which is not a member State,
    - (ii) where the invention is a process, by the importation from such a country of a product obtained directly by means of the process or to which the process has been applied;
  - (d) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms–
    - (i) a market for the export of any patented product made in the United Kingdom is not being supplied, or
    - (ii) the working or efficient working in the United Kingdom of any other patented invention which makes a substantial contribution to the art is prevented or hindered, or
    - (iii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced;
  - (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced.



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(2) Where—

- (a) an application is made on the ground that the patented invention is not being commercially worked in the United Kingdom or is not being so worked to the fullest extent that is reasonably practicable; and
- (b) it appears to the comptroller that the time which has elapsed since the publication in the journal of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked,

he may by order adjourn the application for such period as will in his opinion give sufficient time for the invention to be so worked.

(3) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(a) above if—

- (a) the patented invention is being commercially worked in a country which is a member State; and
- (b) demand in the United Kingdom is being met by importation from that country.

(4) No entry shall be made in the register under section 48 above on the ground mentioned in subsection (1)(d)(i) above, and any licence granted under section 48 above on that ground shall contain such provisions as appear to the comptroller to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee.

(5) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(d)(ii) above unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.]

**Textual Amendments**

**F27** S. 48B inserted (29.7.1999) by [S.I. 1999/1899](#), [reg. 5](#)

**49 Provisions about licences under s. 48.**

(1) Where the comptroller is satisfied, on an application made under section 48 above in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, he may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 48 above is made in respect of a patent by a person who holds a licence under the patent, the comptroller—

- (a) may, if he orders the grant of a licence to the applicant, order the existing licence to be cancelled, or
- (b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

(3) ..... **F28**

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- (4) Section 46(4) and (5) above shall apply to a licence granted in pursuance of an order under section 48 above and to a licence granted by virtue of an entry under that section as it applies to a licence granted by virtue of an entry under section 46 above.

#### Textual Amendments

**F28** S. 49(3) repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), ss. 295, 303(2), Sch. 5 para. 13, [Sch. 8](#)

### 50 Exercise of powers on applications under s. 48.

- (1) The powers of the comptroller on an application under section 48 above in respect of a patent [<sup>F29</sup>whose proprietor is not a WTO proprietor] shall be exercised with a view to securing the following general purposes:—
- (a) that inventions which can be worked on a commercial scale in the United Kingdom and which should in the public interest be so worked shall be worked there without undue delay and to the fullest extent that is reasonably practicable;
  - (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;
  - (c) that the interests of any person for the time being working or developing an invention in the United Kingdom under the protection of a patent shall not be unfairly prejudiced.
- (2) Subject to subsection (1) above, the comptroller shall, in determining whether to make an order or entry in pursuance of [<sup>F30</sup>any application under section 48 above], take account of the following matters, that is to say—
- (a) the nature of the invention, the time which has elapsed since the publication in the journal of a notice of the grant of the patent and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;
  - (b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage; and
  - (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,
- but shall not be required to take account of matters subsequent to the making of the application.

#### Textual Amendments

**F29** Words in s. 50(1) inserted (29.7.1999) by [S.I. 1999/1899, reg. 7\(2\)](#)

**F30** Words in s. 50(2) substituted (29.7.1999) by [S.I. 1999/1899, reg. 7\(3\)](#)

VALID FROM 20/06/2003

### [<sup>F31</sup>50A Powers exercisable following merger and market investigations

- (1) Subsection (2) below applies where—

*Status: Point in time view as at 29/07/1999. This version of this part contains provisions that are not valid for this point in time.*

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- (a) section 41(2), 55(2), 66(6), 75(2), 83(2), 138(2), 147(2) or 160(2) of, or paragraph 5(2) or 10(2) of Schedule 7 to, the Enterprise Act 2002 (powers to take remedial action following merger or market investigations) applies;
  - (b) the Competition Commission or (as the case may be) the Secretary of State considers that it would be appropriate to make an application under this section for the purpose of remedying, mitigating or preventing a matter which cannot be dealt with under the enactment concerned; and
  - (c) the matter concerned involves—
    - (i) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences; or
    - (ii) a refusal by the proprietor of a patent to grant licences on reasonable terms.
- (2) The Competition Commission or (as the case may be) the Secretary of State may apply to the comptroller to take action under this section.
- (3) Before making an application the Competition Commission or (as the case may be) the Secretary of State shall publish, in such manner as it or he thinks appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to it or him to be affected.
- (4) The comptroller may, if it appears to him on an application under this section that the application is made in accordance with this section, by order cancel or modify any condition concerned of the kind mentioned in subsection (1)(c)(i) above or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.
- (5) References in this section to the Competition Commission shall, in cases where section 75(2) of the Enterprise Act 2002 applies, be read as references to the Office of Fair Trading.
- (6) References in section 35, 36, 47, 63, 134 or 141 of the Enterprise Act 2002 (questions to be decided by the Competition Commission in its reports) to taking action under section 41(2), 55, 66, 138 or 147 shall include references to taking action under subsection (2) above.
- (7) Action taken by virtue of subsection (4) above in consequence of an application under subsection (2) above where an enactment mentioned in subsection (1)(a) above applies shall be treated, for the purposes of sections 91(3), 92(1)(a), 162(1) and 166(3) of the Enterprise Act 2002 (duties to register and keep under review enforcement orders etc.), as if it were the making of an enforcement order (within the meaning of the Part concerned) under the relevant power in Part 3 or (as the case may be) 4 of that Act.]

#### Textual Amendments

**F31** S. 50A inserted (20.6.2003) by [Enterprise Act 2002 \(c. 40\)](#), ss. 278, 279, [Sch. 25 para. 8\(2\)](#); S.I. 2003/1397, art. 2(1), Sch. (with arts. 8, 12)

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**Modifications etc. (not altering text)**

- C6** S. 50A(1)(a) amended (20.6.2003) by [The Enterprise Act 2002 \(Protection of Legitimate Interests\) Order 2003 \(S.I. 2003/1592\), art. 1\(1\), Sch. 4 para. 3\(1\)\(a\)](#)
- C7** S. 50A(1)(a) amended (20.6.2003) by [The Enterprise Act 2002 \(Protection of Legitimate Interests\) Order 2003 \(S.I. 2003/1592\), art. 1\(1\), Sch. 4 para. 3\(1\)\(b\)](#)
- C8** S. 50A(6) amended (20.6.2003) by [The Enterprise Act 2002 \(Protection of Legitimate Interests\) Order 2003 \(S.I. 2003/1592\), art. 1\(1\), Sch. 4 para. 3\(1\)\(c\)](#)
- C9** S. 50A(6) amended (20.6.2003) by [The Enterprise Act 2002 \(Protection of Legitimate Interests\) Order 2003 \(S.I. 2003/1592\), art. 1\(1\), Sch. 4 para. 3\(1\)\(d\)](#)
- C10** S. 50A(7) amended (20.6.2003) by [The Enterprise Act 2002 \(Protection of Legitimate Interests\) Order 2003 \(S.I. 2003/1592\), art. 1\(1\), Sch. 4 para. 3\(1\)\(e\)](#)

**[<sup>F32</sup>51 Powers exercisable in consequence of report of [<sup>F33</sup>Competition Commission].**

- (1) Where a report of the [<sup>F34</sup>Competition Commission] has been laid before Parliament containing conclusions to the effect—
  - (a) on a monopoly reference, that a monopoly situation exists and facts found by the Commission operate or may be expected to operate against the public interest,
  - (b) on a merger reference, that a merger situation qualifying for investigation has been created and the creation of the situation, or particular elements in or consequences of it specified in the report, operate or may be expected to operate against the public interest,
  - (c) on a competition reference, that a person was engaged in an anti-competitive practice which operated or may be expected to operate against the public interest, or
  - (d) on a reference under section 11 of the Competition Act 1980 (reference of public bodies and certain other persons), that a person is pursuing a course of conduct which operates against the public interest,

the appropriate Minister or Ministers may apply to the comptroller to take action under this section.
- (2) Before making an application the appropriate Minister or Ministers shall publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected.
- (3) If on an application under this section it appears to the comptroller that the matters specified in the Commission's report as being those which in the Commission's opinion operate, or operated or may be expected to operate, against the public interest include—
  - (a) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences, or
  - (b) a refusal by the proprietor of a patent to grant licences on reasonable terms

he may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.

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- (4) In this section “the appropriate Minister or Ministers” means the Minister or Ministers to whom the report of the Commission was made.]

#### Textual Amendments

- F32** S. 51 substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 14](#)
- F33** Words in s. 51 heading substituted (1.4.1999) by [Competition Act 1998 \(c. 41\)](#), [ss. 45\(4\), 76\(3\)](#); [S.I. 1999/505, art. 2, Sch.](#)
- F34** Words in s. 51(1) substituted (1.4.1999) by [S.I. 1999/506, art. 17](#) (with [art. 3](#))

## [52] <sup>F35</sup> **Opposition, appeal and arbitration.**

- (1) The proprietor of the patent concerned or any other person wishing to oppose an application under sections 48 to 51 above may, in accordance with rules, give to the comptroller notice of opposition; and the comptroller shall consider any opposition in deciding whether to grant the application.
- (2) Where an order or entry has been made under section 48 above in respect of a patent whose proprietor is a WTO proprietor—
- the proprietor or any other person may, in accordance with rules, apply to the comptroller to have the order revoked or the entry cancelled on the grounds that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur;
  - any person wishing to oppose an application under paragraph (a) above may, in accordance with rules, give to the comptroller notice of opposition; and
  - the comptroller shall consider any opposition in deciding whether to grant the application.
- (3) If it appears to the comptroller on an application under subsection (2)(a) above that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur, he may—
- revoke the order or cancel the entry; and
  - terminate any licence granted to a person in pursuance of the order or entry subject to such terms and conditions as he thinks necessary for the protection of the legitimate interests of that person.
- (4) Where an appeal is brought—
- from an order made by the comptroller in pursuance of an application under sections 48 to 51 above;
  - from a decision of his to make an entry in the register in pursuance of such an application;
  - from a revocation or cancellation made by him under subsection (3) above; or
  - from a refusal of his to make such an order, entry, revocation or cancellation,
- the Attorney General, the appropriate Law Officer within the meaning of section 4A of the Crown Suits (Scotland) Act 1857 <sup>F36</sup> or the Attorney General for Northern Ireland, or such other counsel as any of them may appoint, shall be entitled to appear and be heard.
- (5) Where an application under sections 48 to 51 above or subsection (2) above is opposed, and either—
- the parties consent, or

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- (b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him,  
the comptroller may at any time order the whole proceedings, or any question or issue of fact arising in them, to be referred to an arbitrator or arbiter agreed on by the parties or, in default of agreement, appointed by the comptroller.
- (6) Where the whole proceedings are so referred, unless the parties otherwise agree before the award of the arbitrator or arbiter is made, an appeal shall lie from the award to the court.
- (7) Where a question or issue of fact is so referred, the arbitrator or arbiter shall report his findings to the comptroller.]

#### Textual Amendments

- F35** S. 52 substituted (29.7.1999) by S.I. 1999/1899, **reg. 6** (with transitional provisions in **reg. 8(4)**)  
**F36** 1857 c. 44.

### 53 Compulsory licences; supplementary provisions.

- (1) Without prejudice to section 86 below (by virtue of which the Community Patent Convention has effect in the United Kingdom), sections 48 to 51 above shall have effect subject to any provision of that convention relating to the grant of compulsory licences for lack or insufficiency of exploitation as that provision applies by virtue of that section.
- (2) In any proceedings on an [<sup>F37</sup>application made under section 48 above in respect of a patent], any statement with respect to any activity in relation to the patented invention, or with respect to the grant or refusal of licences under the patent, contained in a report of the [<sup>F38</sup>Competition Commission] laid before Parliament under Part VII of the <sup>M6</sup>Fair Trading Act 1973 [<sup>F39</sup>or section 17 of the Competition Act 1980] shall be prima facie evidence of the matters stated, and in Scotland shall be sufficient evidence of those matters.
- (3) The comptroller may make an entry in the register under sections 48 to 51 above notwithstanding any contract which would have precluded the entry on the application of the proprietor of the patent under section 46 above.
- (4) An entry made in the register under sections 48 to 51 above shall for all purposes have the same effect as an entry made under section 46 above.
- (5) No order or entry shall be made in pursuance of an application under sections 48 to 51 above which would be at variance with any treaty or international convention to which the United Kingdom is a party.

#### Textual Amendments

- F37** Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 15(a)**  
**F38** Words in s. 53(2) substituted (1.4.1999) by S.I. 1999/506, **art. 17** (with art. 3)  
**F39** Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 15(b)**

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#### Marginal Citations

M6 1973 c. 41.

### 54 Special provisions where patented invention is being worked abroad.

- (1) Her Majesty may by Order in Council provide that the comptroller may not (otherwise than for purposes of the public interest) make an order or entry in respect of a patent in pursuance of an application under sections 48 to 51 above if the invention concerned is being commercially worked in any relevant country specified in the Order and demand in the United Kingdom for any patented product resulting from that working is being met by importation from that country.
- (2) In subsection (1) above “relevant country” means a country other than a member state [<sup>F40</sup>or a member of the World Trade Organisation] whose law in the opinion of Her Majesty in Council incorporates or will incorporate provisions treating the working of an invention in, and importation from, the United Kingdom in a similar way to that in which the Order in Council would (if made) treat the working of an invention in, and and importation from, that country.

#### Textual Amendments

F40 Words in s. 54(2) inserted (29.7.1999) by S.I. 1999/1899, reg. 7(4)

### *Use of patented inventions for services of the Crown*

### 55 Use of patented inventions for services of the Crown.

- (1) Notwithstanding anything in this Act, any government department and any person authorised in writing by a government department may, for the services of the Crown and in accordance with this section, do any of the following acts in the United Kingdom in relation to a patented invention without the consent of the proprietor of the patent, that is to say—
  - (a) where the invention is a product, may—
    - (i) make, use, import or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing or keeping it; or
    - (ii) in any event, sell or offer to sell it for foreign defence purposes or for the production or supply of specified drugs and medicines, or dispose or offer to dispose of it (otherwise than by selling it) for any purpose whatever;
  - (b) where the invention is a process, may use it or do in relation to any product obtained directly by means of the process anything mentioned in paragraph (a) above;
  - (c) without prejudice to the foregoing, where the invention or any product obtained directly by means of the invention is a specified drug or medicine, may sell or offer to sell the drug or medicine;
  - (d) may supply or offer to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect;

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- (e) may dispose or offer to dispose of anything which was made, used, imported or kept in the exercise of the powers conferred by this section and which is no longer required for the purpose for which it was made, used, imported or kept (as the case may be),  
and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned.
- (2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use of the invention; and “use”, in relation to an invention, in sections 56 to 58 below shall be construed accordingly.
- (3) So far as the invention has before its priority date been duly recorded by or tried by or on behalf of a government department or the United Kingdom Atomic Energy Authority otherwise than in consequence of a relevant communication made in confidence, any use of the invention by virtue of this section may be made free of any royalty or other payment to the proprietor.
- (4) So far as the invention has not been so recorded or tried, any use of it made by virtue of this section at any time either—
- (a) after the publication of the application for the patent for the invention; or
  - (b) without prejudice to paragraph (a) above, in consequence of a relevant communication made after the priority date of the invention otherwise than in confidence;
- shall be made on such terms as may be agreed either before or after the use by the government department and the proprietor of the patent with the approval of the Treasury or as may in default of agreement be determined by the court on a reference under section 58 below.
- (5) Where an invention is used by virtue of this section at any time after publication of an application for a patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) above include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only—
- (a) after such a patent is granted; and
  - (b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.
- (6) The authority of a government department in respect of an invention may be given under this section either before or after the patent is granted and either before or after the use in respect of which the authority is given is made, and may be given to any person whether or not he is authorised directly or indirectly by the proprietor of the patent to do anything in relation to the invention.
- (7) Where any use of an invention is made by or with the authority of a government department under this section, then, unless it appears to the department that it would be contrary to the public interest to do so, the department shall notify the proprietor of the patent as soon as practicable after the second of the following events, that is to say, the use is begun and the patent is granted, and furnish him with such information as to the extent of the use as he may from time to time require.



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- (8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Crown.
- (9) In this section “relevant communication”, in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.
- (10) Subsection (4) above is without prejudice to any rule of law relating to the confidentiality of information.
- (11) In the application of this section to Northern Ireland, the reference in subsection (4) above to the Treasury shall, where the government department referred to in that subsection is a department of the Government of Northern Ireland, be construed as a reference to the Department of Finance for Northern Ireland.

**Modifications etc. (not altering text)**

**C11** S. 55(4) modified by [Atomic Energy \(Weapons Group\) Act 1973 \(c. 4, SIF 8\), s. 5\(2\)](#) (as amended by Patents Act 1977 (c.37 SIF 91), s. 132(5), Sch. 5 para. 6)

**56 Interpretation, etc., of provisions about Crown use.**

- (1) Any reference in section 55 above to a patented invention, in relation to any time, is a reference to an invention for which a patent has before that time been, or is subsequently, granted.
- (2) In this Act, except so far as the context otherwise requires, “the services of the Crown” includes—
  - (a) the supply of anything for foreign defence purposes;
  - (b) the production or supply of specified drugs and medicines; and
  - (c) such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Secretary of State thinks necessary or expedient;and “use for the services of the Crown” shall be construed accordingly.
- (3) In section 55(1)(a) above and subsection (2)(a) above, references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing—
  - (a) to the government of any country outside the United Kingdom, in pursuance of an agreement or arrangement between Her Majesty’s Government in the United Kingdom and the government of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with Her Majesty’s Government in respect of defence matters; or
  - (b) to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty’s Government and that organisation or government, where the thing is required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation.
- (4) For the purposes of section 55(1)(a) and (c) above and subsection (2)(b) above, specified drugs and medicines are drugs and medicines which are both—

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- (a) required for the [<sup>F41</sup>provision of—
- <sup>F41</sup>(i) pharmaceutical services, general medical services or general dental services under Part II of the <sup>M7</sup>National Health Service Act 1977, Part II of the National Health Service (Scotland) Act 1978, or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man, or
  - <sup>F41</sup>(ii) personal medical services or personal dental services provided in accordance with arrangements made under section 28C of the 1977 Act, section 17C of the 1978 Act, or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man]
- and,
- (b) specified for the purposes of this subsection in regulations made by the Secretary of State.

#### Textual Amendments

**F41** S. 56(4)(a)(i)(ii) and immediately preceding words substituted for words in s. 56(4)(a) (1.4.1998) by 1997 c. 46, s. 41(10), **Sch. 2 Pt. 1 para. 2**; S.I. 1998/631, art. 2(1)(b), **Sch. 2** (subject to art. 3, 4, 5)

#### Marginal Citations

**M7** 1977 c. 49.

## 57 Rights of third parties in respect of Crown use.

- (1) In relation to—
- (a) any use made for the services of the Crown of an invention by a government department, or a person authorised by a government department, by virtue of section 55 above, or
  - (b) anything done for the services of the Crown to the order of a government department by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending,
- the provisions of any licence, assignment, assignation or agreement to which this subsection applies shall be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use; and the reproduction or publication of any model or document in connection with the said working or use shall not be deemed to be an infringement of any copyright [<sup>F42</sup>or design right] subsisting in the model or document.
- (2) Subsection (1) above applies to a licence, assignment, assignation or agreement which is made, whether before or after the appointed day, between (on the one hand) any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title, and (on the other hand) any person whatever other than a government department.
- (3) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application concerned, then—
- (a) in relation to anything done in respect of the invention which, but for the provisions of this section and section 55 above, would constitute an

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- infringement of the rights of the licensee, subsection (4) of that section shall have effect as if for the reference to the proprietor of the patent there were substituted a reference to the licensee; and
- (b) in relation to anything done in respect of the invention by the licensee by virtue of an authority given under that section, that section shall have effect as if the said subsection (4) were omitted.
- (4) Subject to the provisions of subsection (3) above, where the patent, or the right to the grant of the patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then—
- (a) in relation to any use of the invention by virtue of section 55 above, subsection (4) of that section shall have effect as if the reference to the proprietor of the patent included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the proprietor of the patent or application and the assignor in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 58 below; and
- (b) in relation to any act done in respect of the invention for the services of the Crown by the proprietor of the patent or application to the order of a government department, section 55(4) above shall have effect as if that act were use made by virtue of an authority given under that section.
- (5) Where section 55(4) above applies to any use of an invention and a person holds an exclusive licence under the patent or application concerned (other than such a licence as is mentioned in subsection (3) above) authorising him to work the invention, then subsections (7) and (8) below shall apply.
- (6) In those subsections “the section 55(4)” payment means such payment (if any) as the proprietor of the patent or application and the department agree under section 55 above, or the court determines under section 58 below, should be made by the department to the proprietor in respect of the use of the invention.
- (7) The licensee shall be entitled to recover from the proprietor of the patent or application such part (if any) of the section 55(4) payment as may be agreed on by them or as may in default of agreement be determined by the court under section 58 below to be just having regard to any expenditure incurred by the licensee—
- (a) in developing the invention, or
- (b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.
- (8) Any agreement by the proprietor of the patent or application and the department under section 55(4) above as to the amount of the section 55(4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the court under section 55(4) above as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard.
- (9) Where any models, documents or information relating to an invention are used in connection with any use of the invention which falls within subsection (1)(a) above, or with anything done in respect of the invention which falls within subsection (1)(b) above, subsection (4) of section 55 above shall (whether or not it applies to any such use of the invention) apply to the use of the models, documents or information as if for

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the reference in it to the proprietor of the patent there were substituted a reference to the person entitled to the benefit of any provision of an agreement which is rendered inoperative by this section in relation to that use; and in section 58 below the references to terms for the use of an invention shall be construed accordingly.

- (10) Nothing in this section shall be construed as authorising the disclosure to a government department or any other person of any model, document or information to the use of which this section applies in contravention of any such licence, assignment, assignation or agreement as is mentioned in this section.

#### Textual Amendments

**F42** Words inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(1), **Sch. 7 para. 20**

#### Modifications etc. (not altering text)

**C12** By [S.I. 1987/1497, reg. 9\(2\) para. 2](#) Table B it is provided that s. 57(1) shall apply as if there were inserted at the end thereof the words, “or of any topography right”

### [<sup>F43</sup>57A Compensation for loss of profit.

- (1) Where use is made of an invention for the services of the Crown, the government department concerned shall pay—
  - (a) to the proprietor of the patent, or
  - (b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee, compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.
- (2) Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing or other capacity; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.
- (3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used.
- (4) No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for the services of the Crown.
- (5) The amount payable shall, if not agreed between the proprietor or licensee and the government department concerned with the approval of the Treasury, be determined by the court on a reference under section 58, and is in addition to any amount payable under section 55 or 57.
- (6) In this section “the government department concerned”, in relation to any use of an invention for the services of the Crown, means the government department by whom or on whose authority the use was made.
- (7) In the application of this section to Northern Ireland, the reference in subsection (5) above to the Treasury shall, where the government department concerned is a

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department of the Government of Northern Ireland, be construed as a reference to the Department of Finance and Personnel.]

#### Textual Amendments

**F43** S. 57A inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 16\(1\)\(4\)](#)

## 58 References of disputes as to Crown use.

[<sup>F44</sup>(1) Any dispute as to—

- (a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,
- (b) terms for the use of an invention for the services of the Crown under that section,
- (c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or
- (d) the right of any person to receive a payment under section 57A,

may be referred to the court by either party to the dispute after a patent has been granted for the invention.]

- (2) If in such proceedings any question arises whether an invention has been recorded or tried as mentioned in section 55 above, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.
- (3) In determining under this section any dispute between a government department and any person as to the terms for the use of an invention for the services of the Crown, the court shall have regard—
  - (a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any government department in respect of the invention in question;
  - (b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the department to use the invention for the services of the Crown on reasonable terms.
- (4) In determining whether or not to grant any relief [<sup>F45</sup>under subsection (1)(a), (b) or (c) above] and the nature and extent of the relief granted the court shall, subject to the following provisions of this section, apply the principles applied by the court immediately before the appointed day to the granting of relief under section 48 of the 1949 Act.
- (5) On a reference under this section the court may refuse to grant relief by way of compensation in respect of the use of an invention for the services of the Crown during any further period specified under section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.

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- (6) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, the court shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment unless the court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.
- (7) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (8) below, grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used for the services of the Crown.
- (8) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded.
- (9) As a condition of any such relief the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.
- (10) In considering the amount of any compensation for the use of an invention for the services of the Crown after publication of an application for a patent for the invention and before such a patent is granted, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use, and if the court finds that it would not have been reasonable, it shall reduce the compensation to such amount as it thinks just.
- (11) Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent (the new proprietor or licensee) and a government department or a person authorised by a government department subsequently makes use under section 55 above of the patented invention, the new proprietor or licensee shall not be entitled to any compensation under section 55(4) above (as it stands or as modified by section 57(3) above) [<sup>F46</sup>, or to any compensation under section 57A above,] in respect of a subsequent use of the invention before the transaction, instrument or event is registered unless—
  - (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
  - (b) the court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.
- (12) In any proceedings under this section the court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as the court may direct, to a Circuit judge discharging the functions of an official referee or an arbitrator in England and Wales or Northern Ireland, or to an arbiter in Scotland; and references to the court in the foregoing provisions of this section shall be construed accordingly.

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- (13) One of two or more joint proprietors of a patent or application for a patent may without the concurrence of the others refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

#### Textual Amendments

- F44** S. 58(1) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 16\(2\)\(4\)](#)
- F45** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 16\(2\)\(4\)](#)
- F46** Words inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 16\(3\)\(4\)](#)

## 59 Special provisions as to Crown use during emergency.

- (1) During any period of emergency within the meaning of this section the powers exercisable in relation to an invention by a government department or a person authorised by a government department under section 55 above shall include power to use the invention for any purpose which appears to the department necessary or expedient—
- (a) for the efficient prosecution of any war in which Her Majesty may be engaged;
  - (b) for the maintenance of supplies and services essential to the life of the community;
  - (c) for securing a sufficiency of supplies and services essential to the well-being of the community;
  - (d) for promoting the productivity of industry, commerce and agriculture;
  - (e) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
  - (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
  - (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside the United Kingdom which is in grave distress as the result of war;
- and any reference in this Act to the services of the Crown shall, as respects any period of emergency, include a reference to those purposes.
- (2) In this section the use of an invention includes, in addition to any act constituting such use by virtue of section 55 above, any act which would, apart from that section and this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 69 below to bring proceedings in respect of the application concerned, and any reference in this Act to “use for the services of the Crown” shall, as respects any period of emergency, be construed accordingly.
- (3) In this section “period of emergency” means any period beginning with such date as may be declared by Order in Council to be the commencement, and ending with such date as may be so declared to be the termination, of a period of emergency for the purposes of this section.

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- (4) A draft of an Order under this section shall not be submitted to Her Majesty unless it has been laid before, and approved by resolution of, each House of Parliament.

### *Infringement*

## **60 Meaning of infringement.**

- (1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—
- (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
  - (b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;
  - (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.
- (2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.
- (3) Subsection (2) above shall not apply to the supply or offer of a staple commercial product unless the supply or the offer is made for the purpose of inducing the person supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the patent by virtue of subsection (1) above.
- (4) Without prejudice to section 86 below, subsections (1) and (2) above shall not apply to any act which, under any provision of the Community Patent Convention relating to the exhaustion of the rights of the proprietor of a patent, as that provision applies by virtue of that section, cannot be prevented by the proprietor of the patent.
- (5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if—
- (a) it is done privately and for purposes which are not commercial;
  - (b) it is done for experimental purposes relating to the subject-matter of the invention;
  - (c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
  - (d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom;



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- (e) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing the United Kingdom (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle;
  - (f) it consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing the United Kingdom as aforesaid or of the importation into the United Kingdom, or the use or storage there, of any part or accessory for such an aircraft.
- (6) For the purposes of subsection (2) above a person who does an act in relation to an invention which is prevented only by virtue of paragraph (a), (b) or (c) of subsection (5) above from constituting an infringement of a patent for the invention shall not be treated as a person entitled to work the invention, but—
- (a) the reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 55 above, and
  - (b) a person who by virtue of [F47 section 28A(4) or (5)] above or section 64 below is entitled to do an act in relation to the invention without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.
- (7) In this section—

“relevant ship” and “relevant aircraft, hovercraft or vehicle” mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than the United Kingdom, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 [F48 or which is a member of the World Trade Organisation]; and

“exempted aircraft” means an aircraft to which [F49 section 89 of the Civil Aviation Act 1982] section 53 of the M8 Civil Aviation Act 1949 (aircraft exempted from seizure in respect of patent claims) applies.

#### Textual Amendments

**F47** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 8\(a\)](#)

**F48** Words in [s. 60\(7\)](#) in the definition of “relevant ship” and “relevant aircraft, hovercraft or vehicle” inserted (29.7.1999) by virtue of [S.I. 1999/1899, reg. 7](#)

**F49** Words substituted by [Civil Aviation Act 1982 \(c. 16, SIF 9\)](#), s. 109, [Sch. 15 para. 19](#)

#### Marginal Citations

**M8** [1949 c. 67.](#)

## 61 Proceedings for infringement of patent.

- (1) Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made—
- (a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;

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- (b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
  - (c) for damages in respect of the infringement;
  - (d) for an account of the profits derived by him from the infringement;
  - (e) for a declaration or declarator that the patent is valid and has been infringed by him.
- (2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.
- (3) The proprietor of a patent and any other person may by agreement with each other refer to the comptroller the question whether that other person has infringed the patent and on the reference the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e) above.
- (4) Except so far as the context requires, in the following provisions of this Act—
- (a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) above and the making of such a reference;
  - (b) any reference to a plaintiff or pursuer includes a reference to the proprietor of the patent; and
  - (c) any reference to a defendant or defender includes a reference to any other party to the reference.
- (5) If it appears to the comptroller on a reference under subsection (3) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.
- (6) Subject to the following provisions of this Part of this Act, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court or the comptroller shall apply the principles applied by the court in relation to that kind of relief immediately before the appointed day.

## **62 Restrictions on recovery of damages for infringement.**

- (1) In proceedings for infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant or defender who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed; and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.
- (2) In proceedings for infringement of a patent the court or the comptroller may, if it or he thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified under section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.
- (3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement

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of the patent committed before the decision to allow the amendment unless the court or the comptroller is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

### **63 Relief for infringement of partially valid patent.**

- (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.
- (2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall not grant relief by way of damages, costs or expenses, except where the plaintiff or pursuer proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the comptroller may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages should be reckoned.
- (3) As a condition of relief under this section the court or the comptroller may direct that the specification of the patent shall be amended to its or his satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

### **[<sup>F50</sup>64 Right to continue use begun before priority date.**

- (1) Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention—
  - (a) does in good faith an act which would constitute an infringement of the patent if it were in force, or
  - (b) makes in good faith effective and serious preparations to do such an act, has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.
- (2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may—
  - (a) authorise the doing of that act by any partners of his for the time being in that business, and
  - (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.
- (3) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.]

#### **Textual Amendments**

**F50** S. 64 substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 17](#)

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## **65 Certificate of contested validity of patent.**

- (1) If in any proceedings before the court or the comptroller the validity of a patent to any extent is contested and that patent is found by the court or the comptroller to be wholly or partially valid, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested.
- (2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the comptroller for infringement of the patent concerned or for revocation of the patent a final order or judgment or interlocutor is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the comptroller otherwise directs, be entitled to his costs or expenses as between solicitor and own client (other than the costs or expenses of any appeal in the subsequent proceedings).

## **66 Proceedings for infringement by a co-owner.**

- (1) In the application of section 60 above to a patent of which there are two or more joint proprietors the reference to the proprietor shall be construed—
  - (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
  - (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any such agreement, is or are the proper person or persons to give the requisite consent.
- (2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

## **67 Proceedings for infringement by exclusive licensee.**

- (1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in the provisions of this Act relating to infringement shall be construed accordingly.
- (2) In awarding damages or granting any other relief in any such proceedings the court or the comptroller shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.
- (3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

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## **68 Effect of non-registration on infringement proceedings.**

Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, the court or the comptroller shall not award him damages or order that he be given an account of the profits in respect of such a subsequent infringement occurring before the transaction, instrument or event is registered unless—

- (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
- (b) the court or the comptroller is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

## **69 Infringement of rights conferred by publication of application.**

- (1) Where an application for a patent for an invention is published, then, subject to subsections (2) and (3) below, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the comptroller for damages in respect of any act which would have infringed the patent; and (subject to subsections (2) and (3) below) references in sections 60 to 62 and 66 to 68 above to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.
- (2) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—
  - (a) after the patent has been granted; and
  - (b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.
- (3) Section 62(2) and (3) above shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court or the comptroller shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court or the comptroller finds that it would not have been reasonable, it or he shall reduce the damages to such an amount as it or he thinks just.

## **70 Remedy for groundless threats of infringement proceedings.**

- (1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4) below,

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bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (3) below.

- (2) In any such proceedings the plaintiff or pursuer shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless—
  - (a) the defendant or defender proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and
  - (b) the patent alleged to be infringed is not shown by the plaintiff or pursuer to be invalid in a relevant respect.
- (3) The said relief is—
  - (a) a declaration or declarator to the effect that the threats are unjustifiable;
  - (b) an injunction or interdict against the continuance of the threats; and
  - (c) damages in respect of any loss which the plaintiff or pursuer has sustained by the threats.
- (4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.
- (5) It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

## **71 Declaration or declarator as to non-infringement.**

- (1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—
  - (a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and
  - (b) that the proprietor has refused or failed to give any such acknowledgment.
- (2) Subject to section 72(5) below, a declaration made by the comptroller under this section shall have the same effect as a declaration or declarator by the court.

### *Revocation of patents*

## **72 Power to revoke patents on application.**

- (1) Subject to the following provisions of this Act, the court or the comptroller may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say—
  - (a) the invention is not a patentable invention;
  - [<sup>F51</sup>(b) that the patent was granted to a person who was not entitled to be granted that patent;]

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- (c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;
  - (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 8(3), 12 or 37(4) above or as mentioned in section 15(4) above, in the earlier application, as filed;
  - (e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.
- (2) An application for the revocation of a patent on the ground mentioned in subsection (1) (b) above—
- (a) may only be made by a person found by the court in an action for a declaration or declarator, or found by the court or the comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and
  - (b) may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.
- (3) ..... F52
- (4) An order under this section may be an order for the unconditional revocation of the patent or, where the court or the comptroller determines that one of the grounds mentioned in subsection (1) above has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 75 below to the satisfaction of the court or the comptroller, as the case may be.
- (5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1) above, whether or not any of the issues involved were decided in the said decision.
- (6) Where the comptroller refuses to grant an application made to him by any person under this section, no application (otherwise than by way of appeal or by way of putting validity in issue in proceedings for infringement) may be made to the court by that person under this section in relation to the patent concerned, without the leave of the court.
- (7) Where the comptroller has not disposed of an application made to him under this section, the applicant may not apply to the court under this section in respect of the patent concerned unless either—
- (a) the proprietor of the patent agrees that the applicant may so apply, or
  - (b) the comptroller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the court.

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#### Textual Amendments

- F51** S. 72(1)(b) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 18](#)
- F52** S. 72(3) repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), [Sch. 8](#)

### 73 **Comptroller’s power to revoke patents on his own initiative.**

- (1) If it appears to the comptroller that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 2(3) above, he may on his own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 76 below.
- [<sup>F53</sup>(2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.
- (3) The comptroller shall not take action under subsection (2) above before—
- (a) the end of the period for filing an opposition to the European patent (UK) under the European Patent Convention, or
  - (b) if later, the date on which opposition proceedings are finally disposed of;
- and he shall not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention.
- (4) The comptroller shall not take action under subsection (2) above if the European patent (UK) has been surrendered under section 29(1) above before the date on which by virtue of section 25(1) above the patent under this Act is to be treated as having been granted or, if proceedings for the surrender of the European patent (UK) have been begun before that date, until those proceedings are finally disposed of; and he shall not then take any action if the decision is to accept the surrender of the European patent.]

#### Textual Amendments

- F53** S. 73(2)(3)(4) substituted for subsections (2) and (3) by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 19](#)

### *Putting validity in issue*

### 74 **Proceedings in which validity of patent may be put in issue.**

- (1) Subject to the following provisions of this section, the validity of a patent may be put in issue—



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- (a) by way of defence, in proceedings for infringement of the patent under section 61 above or proceedings under section 69 above for infringement of rights conferred by the publication of an application;
  - (b) in proceedings under section 70 above;
  - (c) in proceedings in which a declaration in relation to the patent is sought under section 71 above;
  - (d) in proceedings before the court or the comptroller under section 72 above for the revocation of the patent;
  - (e) in proceedings under section 58 above.
- (2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.
- (3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 72 above or otherwise) are the grounds on which the patent may be revoked under that section.
- (4) No determination shall be made in any proceedings mentioned in subsection (1) above on the validity of a patent which any person puts in issue on the ground mentioned in section 72(1)(b) above unless—
- (a) it has been determined in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue that the patent should have been granted to him and not some other person; and
  - (b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced before the end of the period of two years beginning with the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.
- (5) Where the validity of a patent is put in issue by way of defence or counterclaim the court or the comptroller shall, if it or he thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a) above.
- (6) In subsection (4) above “entitlement proceedings”, in relation to a patent, means a reference under [<sup>F54</sup>section 37(1) above] on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration or declarator that it was so granted.
- (7) Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1) above, no proceedings may be instituted without the leave of the court before the comptroller with respect to that patent under section 61(3), 69, 71 or 72 above.
- (8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely because the comptroller is considering its validity in order to decide whether to revoke it under section 73 above.

#### Textual Amendments

**F54** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para.](#)

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### *General provisions as to amendment of patents and applications*

#### **75 Amendment of patent in infringement or revocation proceedings.**

- (1) In any proceedings before the court or the comptroller in which the validity of a patent is put in issue the court or, as the case may be, the comptroller may, subject to section 76 below, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court or comptroller thinks fit.
- (2) A person may give notice to the court or the comptroller of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court or the comptroller shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.
- (3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.
- (4) Where an application for an order under this section is made to the court, the applicant shall notify the comptroller, who shall be entitled to appear and be heard and shall appear if so directed by the court.

#### **[<sup>F55</sup>76 Amendments of applications and patents not to include added matter.**

- (1) An application for a patent which—
  - (a) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted, and
  - (b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed,
 may be filed under section 8(3), 12 or 37(4) above, or as mentioned in section 15(4) above, but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.
- (2) No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.
- (3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it—
  - (a) results in the specification disclosing additional matter, or
  - (b) extends the protection conferred by the patent.]

#### **Textual Amendments**

**F55** S. 76 substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 20](#)

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VALID FROM 28/07/2000

**[<sup>F56</sup>76A *Biotechnological inventions***

- (1) Any provision of, or made under, this Act is to have effect in relation to a patent or an application for a patent which concerns a biotechnological invention, subject to the provisions of Schedule A2.
- (2) Nothing in this section or Schedule A2 is to be read as affecting the application of any provision in relation to any other kind of patent or application for a patent.]

**Textual Amendments**

**F56** S. 76A inserted (28.7.2000) by [S.I. 2000/2037](#), [reg. 5](#)

**Status:**

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